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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/616,349	07/09/2003	Gregory S. Snider	0275S-000739	1539

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EXAMINER	
REIS, TRAVIS M	

ART UNIT	PAPER NUMBER
2859	

DATE MAILED: 11/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/616,349	SNIDER, GREGORY S.	
	Examiner	Art Unit	
	Travis M Reis	2859	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 September 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-18* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1, 2, 4-6, 8-11, 13, & 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bell (U.S. Patent 4742875) in view of Clontz (U.S. Patent 5119521).

Bell discloses a power tool (10) comprising a housing (14), said housing having a desired configuration defining a shape of the power tool, said housing having a hand manipulation portion (22) on said housing and said housing having a motor receiving portion (20) and a power source receiving portion (26)(Figure 1), a motor (32) positioned within said housing (Figure 2), a power source being a battery (28) (Figure 1) coupled with said motor having a portion positioned in said housing for operating said motor; an output (64) coupled with said motor and adapted to be coupled with a tool (74), said output having a portion positioned inside said housing (Figure 3), an activation member (24) positioned on said housing and coupled with said motor for activating and deactivating said motor which, in turn, drives and idles said output.

Bell does not disclose a tape measure positioned in a chamber in said housing such that said measuring device is prohibited from interference with operation of said motor and/or power source, and said measuring device operable while in said housing and measuring device removable from said housing for operation outside of said housing.

Clontz discloses a tape measure (T) for hand tools (H) with said tape measure positioned in a housing where it does not interfere with the operation of any motor or battery,

said tape measure being operable while in said housing (Figure 1); said housing including a chamber for receiving said tape measure and being removable from said housing (Figure 6) in order to avoid loss of the tape measure in use (col. 1 lines 34-39). Therefore, it would have been obvious to one with ordinary skill in the art at the time of the invention was made to add the tape measure disclosed by Clontz next to the batteries disclosed by Bell. in order to avoid loss of the tape measure in use.

3. Claims 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bell & Clontz as applied to claims 1, 2, 4-6, 8-11, 13, & 14, and in further view of Bunyea et al. (U.S. Patent 5663011).

Bell & Clontz disclose all of the instant claimed invention as stated above in the rejection of claims 1, 2, 4-6, 8-11, 13, & 14, but do not disclose a tape measure ejector including a body & a pair of retention arms in a chamber for locking said tape measure within said chamber and forcing the tape measure out when said ejector is activated.

Bunyea et al. discloses a battery pack retaining latch for cordless devices with a body (364) including a pair of arms (370) for locking batteries (29) within a chamber (34) and forcing the batteries out when said ejector is activated (356) (Figures 19 & 22) in order to be easily coupled and removed from the device (col. 1 lines 26-29). Therefore, it would have been obvious to one with ordinary skill in the art at the time of the invention was made to add the retaining latch disclosed by Bunyea et al. to the measuring attachment disclosed by Bell & Clontz in order that the measuring attachment will be easily coupled & removed.

4. Claims 3, 7, & 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bell & Clontz as applied to claims 1, 2, 4-6, 8-11, 13, & 14 above, and further in view of Hines (U.S. Patent 4976037).

Bell & Clontz disclose all of the instant claimed invention as stated above in the

rejection of claims 1, 2, 4-6, 8-11, 13, & 14, but do not disclose an end member on said tape measure enabling marking of a workpiece.

Hines discloses a marking (44) and cutting (36) device (1) on an end member (41) of a tape measure (21) for marking/cutting patterns in a workpiece (col. 1 lines 23-25). Therefore, it would have been obvious to one with ordinary skill in the art at the time of the invention was made to add the end member disclosed by Hines to the end of the tape measure disclosed by Bell & Clontz in order to mark/cut patterns in a workpiece.

Response to Arguments

5. In response to applicant's argument that Bell does not disclose or suggest the need or desire to have any type of measuring device and that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Clontz discloses the necessary motivation for coupling measuring devices with hammers, i.e. to avoid the loss of a tape measure used in combination with a hammer in carpentry, as detailed above in paragraph 2.

6. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d

1392, 170 USPQ 209 (CCPA 1971). In this case, the teachings of Clontz provide sufficient knowledge to one skilled in the art to combine measuring devices in the handle of tools.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Travis M Reis whose telephone number is (571) 272-2249. The examiner can normally be reached on 8--5 M--F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego Gutierrez can be reached on (571) 272-2245. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306 for all communications.

Travis M Reis
Examiner
Art Unit 2859

Diego Gutierrez
Supervisory Patent Examiner
Technology Center 2800

tmr
November 15, 2004